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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,680	04/05/2001	Michael G. Coutts	8717.00	3504

26889	7590	07/13/2006		EXAMINER

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ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/826,680	COUTTS ET AL.
	Examiner	Art Unit	
	DANIEL LASTRA	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _27 March 2006_.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _16-32_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _16-32_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 16-32 have been examined. Application 09/826,680 (SELF-SERVICE

TERMINAL) has a filing date 04/05/2001 and foreign priority date 04/07/00.

Response to Amendment

2.   In response to Non Final Rejection filed 12/23/2005, the Applicant filed an

Amendment on 03/27/2006, which amended claims 25, 27 and 29.

Claim Objections

3.   Claim 27 is objected to because of the following informalities: Claim 27 recites

"(Presently Amendment)" when it should recites (Currently Amended).

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under
section 122(b), by another filed in the United States before the invention by the
applicant for patent or (2) a patent granted on an application for patent by
another filed in the United States before the invention by the applicant for patent,
except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application
filed in the United States only if the international application designated the
United States and was published under Article 21(2) of such treaty in the English
language.

Claims 16-24, 26-28 and 30-32 are rejected under 35 U.S.C. 102(e) as being

anticipated by Drummond (US 2005/0216888).

As per claims 16, 19, 20, 22, 26, 28 and 30, Drummond teaches:

An automated teller machine (ATM) for dispensing cash in the form of paper money to an ATM customer conducting a cash dispense transaction at the ATM and for displaying advertisements for the ATM customer to view while the ATM customer is conducting the cash dispense transaction at the ATM, the ATM comprising:

a cash dispenser for dispensing cash to an ATM customer when the customer is conducting a cash dispense transaction at the ATM (see paragraph 116);

an ATM display (see paragraph 88);

means for accessing an advertisement database to retrieve an authorized advertisement associated with the ATM (see paragraph 88); and

means for incorporating the retrieved advertisement in a screen for displaying on the ATM display to allow the ATM customer to view the screen while the ATM customer is conducting the cash dispense transaction at the ATM (see paragraphs 115-116; 118-122).

As per claim 17, Drummond teaches:

An ATM according to claim 16, wherein the means for incorporating the retrieved advertisement in a screen includes an ATM program for executing a Web browser (see paragraph 74).

As per claim 18, Drummond teaches:

An ATM according to claim 17, wherein the ATM program is operable to allocate screen space to the Web browser in accordance with predefined allocation times (see paragraph 114).

As per claim 21, Drummond teaches:

A method according to claim 20, further comprising the steps of:

logging the number of times the advertisement database has been accessed by each ATM and applying a charge to each advertisement based on the number of accesses (see paragraph 116).

As per claim 23, <u>Drummond</u> teaches:

The system of claim 22, wherein the configuration of the system is such that an authorized user is allowed to update the stored advertisements (see paragraph 121).

As per claim 24, <u>Drummond</u> teaches:

A system according to claim 22, wherein the server is configured to allow a user to enter descriptive fields relating to an advertisement (see paragraph 121).

As per claim 27, <u>Drummond</u> teaches:

A method of offsetting the cost of owning an automated teller machine (ATM) which can dispense cash in the form of paper money to an ATM customer conducting a cash dispense transaction at the ATM , the method comprising the steps of:

providing a database for storing advertisements (see paragraph 116);

allowing an authorized ATM customer to access the database and to transmit an advertisement *from an ATM* to the database for storing therein and screening the transmitted advertisement to ensure that it meets an acceptance criterion (see paragraphs 103, 121, 122) and storing the screened advertisement in a database entry associated with the ATM and charging a fee to the ATM customer each time the advertisement is accessed by the ATM (see paragraph 116).

As per claims 31 and 32, <u>Drummond</u> teaches:

ATM according to claim 16, wherein the retrieved advertisement is displayed while cash is being counted or staged by the ATM (see paragraphs 116, 122).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond (US 2005/0216888) in view of Gupta (US 6,487,538).

As per claim 25, Drummond teaches:

A system according to claim 22, further comprising a screening system for screening each advertisement to determine if the information fulfils an acceptance criterion (see paragraph 103, 121, 122) but fails to teach *and, if not, rejecting the advertisement.* However, Gupta teaches a system that allows content providers to exclude or allow advertisements from his website (see Gupta column 15, lines 50-55). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Drummond ATM terminals operators would screen the received third party advertisements by categories/types in order to allow/deny said advertisements and screened unacceptable advertisements. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that public ATM terminals would screen and censor advertisements in

order to avoid offending customers with advertisements that said customers would have found offensive.

As per claim 29, Drummond teaches:

A method of leasing advertising space on one or more automated teller machines (ATMs) in a network of ATMs which can dispense cash in the form of paper money, the method comprising the step of:

providing a database for storing authorized advertisements (see paragraph 116)

allowing a third party to access the database and to transmit an advertisement thereto (see paragraph 116);

screening the transmitted advertisement (see paragraph 115);

Drummond does not expressly teach in the event of the screened advertisement meeting an acceptance criterion, storing the transmitted advertisement, *and if the advertisement fails to meet the criterion, rejecting it*; associating display criteria with the stored advertisement; transmitting the stored advertisement to any request from an ATM fulfilling the display criteria. However, Gupta teaches a system that allows content providers to exclude or allow advertisements from his website (see Gupta column 15, lines 50-55). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Drummond ATM terminals operators would screen the received third party advertisements by categories/types in order to allow/deny said advertisements and screened unacceptable advertisements. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that public ATM terminals would screen and censor

advertisements in order to avoid offending customers with advertisements that said customers would have found offensive.

Drummond teaches applying a charge to an account associated with the third party (see paragraph 116), *wherein all steps are undertaken by a single entity and its agents* (see paragraphs 35 and 248).

Response to Arguments

6.   Applicant's arguments filed 03/27/2006 have been fully considered but they are not persuasive. Applicant argues that the Drummond reference cannot be used as prior art because Applicant's foreign priority date 04/07/00 precedes the Drummond published application WO 98/24041, which was published on June 1998 but does not show Applicant's claims. Therefore, the Applicant argues that it is clear that the subject matter in Drummond 888 which is used to reject Applicant's claims was added after the filing date and therefore, cannot be used to reject the Applicant's claims.

The Examiner answers that the Drummond 888 reference claims priority to provisional application 60/149,765 (08/19/1999), which has complete support for the Drummond 888 reference. Therefore, the Drummond 888 reference is not withdrawn from the rejection.

The Applicant argues that Drummond does not teach a browser made available at allocation times. The Examiner answers that Drummond teaches that ATM terminal communicates using HTML documents, TCP/IP messages and an Internet Browser (see paragraphs 9 and 14).

The Applicant argues regarding to claim 21 that no database has been shown in a usable reference and that <u>Drummond</u> does not teach billing. The Examiner answers that <u>Drummond</u> teaches that advertisements documents may be accessed from advertisers servers (i.e. database) connected to the network and that the operator of the system may also require payment from advertisers for presenting the advertising materials[1]. Therefore, contrary to Applicant's arguments <u>Drummond</u> teaches billing and a database. Also, the Applicant argues regarding to claim 21 that a billing is generated in said claim. The Examiner answers that claim 21 recites "applying a charge to each advertisement based on the number of accesses". Nowhere, in said limitation is recited that a billing is generated.

The Applicant further argues that in <u>Drummond</u>, an advertiser may pay $1000 for the option to place 10 advertisements at any times he wants, or pay a lesser sum if the ads are placed at inconvenient times and that, according to the Applicant, does not show the claimed invention. The Examiner answers that the Applicant is arguing about features that are not stated in the claims.

The Applicant argues with respect to claim 24 that <u>Drummond</u> does not teach "entering of descriptive fields relating to an advertisements by a user". The Examiner answers that <u>Drummond</u> that operators of ATMs can target advertisements based upon categories of customer or even targeted on a segment basis (see paragraph 121). Therefore, it is inherent that said operators enter descriptive fields of the categories to target said advertisements.

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[1] Drummond paragraph 116

The Applicant argues with respect to claim 27 that <u>Drummond</u> does not teach that the "advertisement is stored in a database entry associated with the ATM". The Examiner answers that <u>Drummond</u> teaches that advertisement documents may be accessed from advertising servers connected to the network (see paragraph 116). Therefore, <u>Drummond</u> teaches that advertisements are stored in databases (i.e. advertising servers) associates with the ATM (i.e. connected to the network and link to the ATMs).

The Applicant argues with respect to claim 29 that in <u>Drummond</u> the owner of the website supplies the advertising to the website and therefore, according to the Applicant, there is no "third party" present. The Examiner answers that <u>Drummond</u> teaches that third parties advertisers transmit their advertisements from their advertising servers to the ATM terminals when said third parties advertisers buy advertisements place in said ATM terminals[2]. Therefore, contrary to Applicant's argument, in <u>Drummond,</u> third parties advertisers and not the owner of the website (i.e. operator of the ATM terminals) supplies the HTML files corresponding to those third parties' products or services which would be displayed in said ATM terminals.

The Applicant argues with respect to claim 29 that <u>Drummond</u> does not teach the limitation that the steps of the claims are undertaken by a single entity and its agents because <u>Drummond</u> does not teach that parties who performs all steps are not acting together. The Examiner answers that the Applicant is arguing about limitation that are not stated in the claims. Claim 29 recites "*wherein all steps are undertaken by a single*

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[2] Drummond paragraph 116

entity and its agents". Said limitation does not recite anything about not acting together or acting together. <u>Drummond</u> teaches agents and entities performing all the steps of the <u>Drummond</u> invention (see paragraphs 35 and 248). Therefore, Drummond teaches the Applicant's claimed invention.

Conclusion

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.   Accordingly, **THIS ACTION IS MADE FINAL**.   See MPEP § 706.07(a).   Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action.   In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.   In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
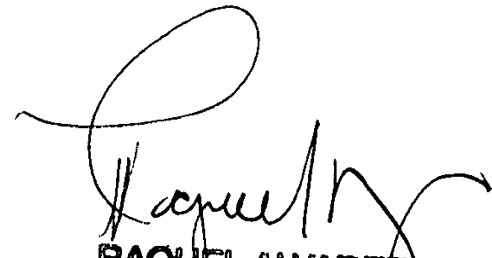
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
June 3, 2006

RAQUEL ALVAREZ
PRIMARY EXAMINER